

### **REMARKS**

Applicants hereby request further consideration of the application in view of the amendments above and the comments that follow.

### **Status of the Claims**

Claims 1-49 are pending in the application. Claims 39-49 have been withdrawn from consideration as being drawn to a non-elected claim group. Claims 1, 7-9, 12-13, 16-17, 23-25, 28-29, 32-38 stand rejected under Section 102(b) as being anticipated by U.S. Patent No. 4,488,415 to Jenkins (Jenkins). Claims 1, 14, 17 and 30 stand rejected under Section 102(b) as being anticipated by U.S. Patent No. 2,811,024 to Thompson (Thompson). Claims 15 and 31 stand rejected under Section 103(b) as being unpatentable over Jenkins.

### **The Rejections under Sections 102 and 103**

A finding of anticipation further requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. *See Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991). Thus, anticipation requires that a single prior art reference disclose each and every element of the anticipated claim.

To establish a prima facie case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claim, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As recently emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In an even more recent decision, the Court of

Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, **would have selected these components for combination in the manner claimed**. *In re Kotzab*, 55, USPQ2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, both the CCPA and the Federal Circuit have consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the primary reference, such a proposed modification is not proper and the prima facie case of obviousness cannot properly be made. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

**Claims 1-32:**

Claim 1 stands rejected under Section 102 as being anticipated by either Jenkins or Thompson. Claim 1 recites:

1. A jewelry piece comprising:
  - a) a gemstone mount assembly including:
    - 1) a base member defining a base cavity and having first and second opposed ends, the base member tapering from the first end to the second end and defining a base opening in the first end; and
    - 2) a bezel member mounted on the first end of the base member and defining a bezel opening;
    - 3) wherein the bezel member is **bonded** to the first end of the base member; and
  - b) a gemstone mounted in the gemstone mount assembly and captured between the base member and the bezel member, wherein the gemstone is received in the base cavity and extends through the base opening and the bezel opening.

Bonding of the bezel member to the first end of the base member as claimed may provide various advantages over jewelry pieces of the prior art. The claimed bonded gemstone mount assembly may be particularly advantageous in that the gemstone mount assembly may be formed so as to be relatively light in weight. This may be particularly

beneficial in the case of an earring where excess weight may tend to cause the earring to droop. The gemstone mount assembly and the jewelry piece provide an overall aesthetically pleasing appearance. The bezel member can be unobtrusive and may serve as a decorative element. Because it is not necessary to bend prongs or the like to secure the gemstone within the gemstone mount assembly, the associated high heat (*e.g.*, using a torch) and metal work are not required and heat-sensitive and pressure-sensitive stones can be used without elevated risk of damage or special care. The gemstone mount assembly can be quickly assembled without requiring significant skill.

Regarding the rejection of Claim 1 over Jenkins, the Action contends that "Jenkins teaches an article of decorative jewelry... 3) wherein the bezel member is bonded to the first end of the base member (16 mounted to 12 via 14 in Fig. 2)." Action at page 3. Applicants respectfully disagree. In Jenkins, the bezel **16** is not bonded to the top ring **12**. Rather, the bezel **16** is mechanically joined to the top ring **12** by a hinge **14** and a catch **18**, and such joinder cannot be properly regarded as bonded.

Nor would it have been obvious to the ordinarily skilled artisan to modify the Jenkins ring to include bonding of the bezel **16** to the top ring **12**. Such a modification would have destroyed, at least in part, the stated functionality of the Jenkins ring, which is to provide for interchangeability of stones in the ring. (*See, e.g.*, Jenkins at col. 1, line 56 - col. 2, line 3, and col. 3, lines 35-43).

Regarding the rejection of Claim 1 over Thompson, the Action contends that "Thompson teaches an article of decorative jewelry... 3) wherein the bezel member is bonded to the first end of the base member (17 mounted to 9 via 21 and 20 in Figs. 2 and 3)." Action at pages 8 and 9. Elements **17** and **9** designate clamps of a platen **12** and a head **7**, respectively. Accordingly, as understood by Applicants, the Action intends to identify the platen **12** as corresponding to the claimed bezel and the head **7** as corresponding to the claimed base member.

In Thompson, the gem **15** is held by the clamps **17**, not the clamps **9** as suggested by the Action. The gem **15** is held on top of the platen **12** in a conventional mounting arrangement (*See, e.g.*, Thompson at col. 4, lines 14-18). Thus, the gem **15** is not "captured

**between**" a bezel and a base member as recited in Claim 1. Accordingly, Claim 1 is not anticipated by Thompson for at least this reason.

Additionally, Thompson does not teach that the platen **12** may be **bonded** to the head **7**. Rather, the platen **12** can be temporarily or permanently secured to the head **7** by the bendable clamps **9**. Accordingly, Claim 1 is not anticipated by Thompson for at least this further reason.

Nor would it have been obvious to the ordinarily skilled artisan to modify the Thompson ring to include bonding of the platen **12** to the head **7**. Such a modification would have destroyed, at least in part, the stated functionality of the Thompson ring, which is to provide for interchangeability of stones in the ring. (*See, e.g.*, Thompson at col. 1, lines 17-25).

Claims 2-16 depend from Claim 1 and are therefore allowable as well for at least the foregoing reasons. At least certain of the dependent claims are further distinguishable from the cited art as discussed below.

The Action contends at page 11 that Claims 2-6 are directed to product-by-process claims and has refused to give the recitations of these claims patentable weight. In order to expedite prosecution of the present application, Applicants have amended Claims 2-5 to more positively recite the claimed features as components of the claimed product. Claim 6 as originally presented clearly is not a product-by-process claim; rather, the friction fit engagement is an existing and continuing aspect of the recited product (additional to the bond between the bezel and the base member), not merely a process step. Applicants respectfully submit that the recitations of Claims 2-6 as amended are now clearly entitled to full patentable weight. Applicants further submit that the cited art fail to teach or suggest a product as claimed having the components or features recited in Claims 2-6. Accordingly, Claims 2-6 are further distinguishable from the cited art for at least these additional reasons.

Claim 17 stands rejected on the same grounds discussed above with regard to Claim 1. Claim 17 recites a gemstone mount assembly as recited in Claim 1, except that in place of the recitation of a gemstone mounted in the gemstone mount assembly, Claim 17 recites that the gemstone mount assembly is adapted to capture a gemstone in the manner recited in Claim 1. Accordingly, Claim 17 is allowable over the cited art for the reasons set forth above.

with regard to Claim 1. Claims 18-32 depend from Claim 17 and are therefore allowable as well for at least the foregoing reasons. Claims 18-21 have been amended in the same manner as Claims 2-5. Therefore, Claims 18-22 are further distinguishable from the cited art for at least the reasons discussed above with regard to Claims 2-6.

**Claims 33-38:**

Claims 33 and 36 each stand rejected under Section 102 as anticipated by Jenkins. The Action contends that "Jenkins teaches of an article of decorative jewelry... 3) wherein at least one of a decorative embossment and a decorative cutout is defined in an outer surface of the base member (decorative spaces/cutouts between vertical segments 8 in Fig. 2)." Action at page 6.

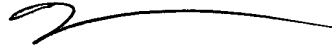
Claims 33 and 36 have each been amended to recite that "the at least one of a decorative embossment and a decorative cutout represents a **brand designation**." Jenkins in no way teaches or suggests such a feature. Accordingly, Applicants respectfully submit that Claims 33 and 36 and dependent Claims 34, 35, 37 and 38 are allowable over the cited art for at least these reasons.

In re: Lodholz  
Serial No.: 10/647,745  
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**CONCLUSION**

Applicants respectfully submit that this application is now in condition for allowance, which action is requested. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,

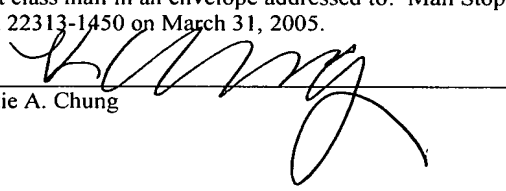


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